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10/698,349	10/31/2003	Edward M. Tecot	MS1-1645US	9655
22801 7590 07/28/2010 LEE & HAYES, PLLC 601 W. RIVERSIDE AVENUE SUITE 1400 SPOKANE, WA 99201				
EXAMINER				
SAINT CYR, JEAN D				
ART UNIT		PAPER NUMBER		
2425				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lhptoms@leehayes.com

### Office Action Summary

**Application No.**

10/698,349

**Applicant(s)**

TECOT ET AL.

**Examiner**

JEAN Duclos SAINT CYR

**Art Unit**

2425

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Continued Examination Under 37 CFR 1.114.**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/13/2010 has been entered.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 27 is provisionally rejected on the ground of nonstatutory double patenting over claims 1 of copending Application No. 12098971, hereinafter referred to as '971. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Current application	Co-pending application
<p>Claim 27:</p> <p>A processor-readable medium having processor- executable instructions that, when executed by a processor, perform operations comprising: presenting a first user interface (UI) on a first multimedia presentation system at a first locus, the first UI providing a listing of multiple loci within a physical environment to which a bookmark can be sent;</p> <p>receiving through the first UI, a user request to send a bookmark to a specified second locus from among the multiple loci,</p>	<p>Claim 1:</p> <p>A processor-readable storage medium having processor-executable instructions that, when executed by a processor, instructs the processor to perform operations performs a method comprising: generating a bookmark to mark "bookmark" at a point during a presentation of a program, the program being presented through a first presentation system at a first physical location within a physical environment; receiving through a user interface at the</p>

<p>the second locus including a second multimedia presentation system, the bookmark including an indication of a point within a multimedia program;</p> <p>sending the bookmark to the second multimedia presentation system at the second locus;</p> <p>in response to the second multimedia presentation system receiving the bookmark, and without user interaction, presenting a second UI user interface on the second multimedia presentation system -the second prompting for user-selection to resume the multimedia program at the second multimedia presentation system; response to presenting the second UI, receiving a user selection through the second requesting that a communicatively coupled multimedia server -stream to the second multimedia presentation system the multimedia program, beginning from the point within the multimedia program indicated by the bookmark; and</p> <p>presenting the-multimedia program at the second multimedia presentation system from the point within the multimedia program indicated by the bookmark.</p>	<p>first presentation system, a user selection of a second presentation system at a second physical location within the physical environment, the user selection indicating that the bookmark is to be sent to the second presentation system; and</p> <p>in response to the user selection of the second presentation system through the user interface at the first presentation system, sending the bookmark to the second presentation system, causing the second presentation system to present a user interface indicating the ability to resume, through the second presentation system, presentation of the program from the point marked by the bookmark.</p>
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The only difference between claim 27 and claim 1 is that : in claim 27 the user has the option to specify a second location where he will need to resume his bookmarked program, but in claim 1, the user has not the option for specifying location for resuming bookmarked program. However, in both claims, user can bookmark program and can resume the bookmarked program at a second location from another device.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 27 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. That claim discloses a processor readable medium and that processor readable medium described open-ended in the specification. For example, the applicant discloses in paragraph 206 that processor-readable media may comprise "computer storage media" and "communications media." And applicant disclose in paragraph 208 that "Communication media" typically embodies processor-readable instructions, data structures, program modules, or other data in a modulated data signal, such as carrier wave or other transport mechanism.

***Claim Rejections - 35 USC § 112, Second Paragraph***

Claim 37 is rejected under 35 U.S.C. 112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It recites the language "means for" without a clearly defined corresponding structure from the specification. In other words, one of ordinary skill in the art would not be able to precisely identify the associated structure, material, or acts

necessary for achieving the specified function within the specification – See MPEP 2181 IV.

Claim elements “means for presenting a UI on the first multimedia presentation system, the UI including a display of the bookmark and a prompt for user input to accept the bookmark and resume presentation of the multimedia program at the first multimedia presentation system, the UI being presented in direct response to receiving the bookmark, the UI not being presented in response to user interaction with the first multimedia presentation system; means for receiving -user input through the UI that indicates a user request to resume presentation of the that the user selects the bookmarked multimedia program from the position of the bookmark; means for requesting that a communicatively coupled multimedia server stream to the first multimedia presentation system, multimedia program from the position of the bookmark; and means for presenting the multimedia program at the first multimedia presentation system from the position of the bookmark” is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. There is no sufficient algorithm disclosing that function in the specification.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph;

or(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

- (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or
- (b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

#### **Response to Amendment**

This action is in response to applicant's amendment filed on 05/13/2010. Claims 27-37 are still pending in the current application. Claims 44-49 and 51-61 are cancelled. **This action is made NON-FINAL.**

#### **Response to Arguments**

Applicant's arguments with respect to claims 27-37 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that Roberts et al did not disclose bookmarking a location within a multimedia presentation such that the multimedia can be resumed from that bookmark location. Also, applicant argues that Thomas only discloses freezing on-demand media, and later resuming the frozen media at another location, but Thomas did not allow the user to specify where he will resume the media content.

However, Vasilevsky et al disclose place a program bookmark in a program representing a point in the program where reproduction has stopped, and from another reproduction device, resume reproduction of the program from the program bookmark,0021; the media server being adapted to upon the demand of a user via a reproduction device, transmit in a reproducible format, programs to the reproduction devices,0021; rendering the decoded and decrypted signals compatible for display with the television receivers 124, 128 and 132,0034; the same program can be resumed from the same pause point and viewed, but from a different receiver,0049.



And Shteyn et al disclose lets the user specify in advance a location for play-out of a specific broadcast or multicast program pre-recorded in response to the user's selection, and has the content made available to him or her at that location,col.1, lines 35-58; it is clear that the user has the option to specify the location where he wants to resume the content and the information will be available at that location automatically; this information proves that the system allows user to input a bookmark from one device and the user is capable of specifying the location for resuming the bookmark from another device. As a result, this action is made non-final.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vasilevsky et al in view of Shleyn et al, US No.6611654 .

Re claim 27, Vasilevsky et al disclose presenting a first user interface on a first multimedia presentation system at a first locus(see fig.2; a general Graphical User Interface display provided to system users, 0025; the input signals are in response to a graphical user interface displayed on the receiver screens,0039)

in response to the second multimedia presentation system receiving the bookmark, and without user interaction, presenting a second UI user on the second multimedia presentation system the second prompting for user-selection to resume the multimedia program at the second multimedia presentation system(place a program bookmark in a

program representing a point in the program where reproduction has stopped, and from another reproduction device, resume reproduction of the program from the program bookmark,0021) ;

in response to presenting the second UI, receiving a user selection through the second UI (upon the demand of a user,0022);

requesting that a communicatively coupled multimedia server stream to the second multimedia presentation system the multimedia program, beginning from the point within the multimedia program indicated by the bookmark; and presenting the multimedia program at the second multimedia presentation system from the point within the multimedia program indicated by the bookmark(the media server being adapted to upon the demand of a user via a reproduction device, transmit in a reproducible format, programs to the reproduction devices,0021; rendering the decoded and decrypted signals compatible for display with the television receivers 124, 128 and 132,0034; the same program can be resumed from the same pause point and viewed, but from a different receiver,0049);

the second locus including a second multimedia presentation system, the bookmark including an indication of a point within a multimedia program(see fig.1, element 128; see fig.7; the bookmark display 400 can contain all of the active bookmarks for the program, or only those to which the user has access,0055).

But did not explicitly disclose the first UI providing a listing of multiple loci within a physical environment to which a bookmark can be sent;

receiving, through the first UI, a user request to send a bookmark to a specified second locus from among the multiple loci; sending the bookmark to the second multimedia presentation system at the second locus.

However, Shteyn et al disclose the first UI providing a listing of multiple loci within a physical environment to which a bookmark can be sent(enables the user to select in advance at least a specific one from multiple geographically different locations at which the recorded, selected content information will be made available for play-out, col.1, lines 39-43);

receiving, through the first UI, a user request to send a bookmark to a specified second locus from among the multiple loci, sending the bookmark to the second multimedia presentation system at the second locus(in response to the user's selection, and has the content made available to him or her at that location, col.1, lines 55-64).

It would have been obvious for any person of ordinary skill in the art at that time the invention was made to incorporate the teaching of Shteyn into the system of Vasilevsky for the purpose of allowing users to specify where they want to resume their contents remotely.

Re claim 28, Vasilevsky et al disclose wherein the first UI -includes a listing of bookmarks associated with a particular multimedia program, and the -user -request to send a bookmark includes a bookmark selected from the listing of the bookmarks associated with the particular multimedia program(audio programs, 0031).

Re claim 29, Vasilevsky et al disclose wherein the first UI includes a listing of bookmarks associated with a particular multimedia program based upon one or more properties associated with the bookmarks(see fig.6; brief description of what occurred in the program just prior to the pause point,0057) .

Re claim 30, Vasilevsky et al disclose wherein the second UI includes a listing of one or more bookmarks associated with a particular multimedia program based upon one or more properties associated with the bookmarks; the one or more properties being selected from a group consisting of: identity of -the particular multimedia program;

relative point of the bookmark during the presentation of the particular multimedia program; a category of the particular multimedia program ; a locus of a system where the particular multimedia program was bookmarked; identity of a user who manually bookmarked the particular multimedia program; chronological time of generation of the bookmark; chronological date of generation of the bookmark(see fig.7, user name and identity of the program).

Re claim 31, wherein the second UI graphically illustrates one or more of the following: identity of the multimedia program; relative point of the bookmark during presentation of the selected bookmarked multimedia program; a category of the multimedia program; a locus of a system where the -multimedia program was bookmarked; identity of a user who bookmarked the multimedia program; chronological time when the multimedia program was bookmarked; chronological date when the multimedia -program was bookmarked; relative time when the multimedia program was bookmarked(see fig.2, chronological date).

Re claim 32, Vasilevsky et al disclose wherein the second UI includes a listing of broadcast media programs that have one or more bookmarks(see fig.4; 0055).

Re claim 33, Vasilevsky et al disclose wherein the second UI includes a listing of broadcast media programs available with indicators corresponding with broadcast media programs that have one or more bookmarks(see fig.2).

Re claim 34, Vasilevsky et al disclose wherein the second UI includes a grid listing of broadcast media programs available with indicators corresponding with broadcast media programs that have one or more bookmarks(see fig.7, bookmark listing).

Re claim 35, Vasilevsky et al disclose wherein the second UI includes a listing of broadcast media programs available with indicators corresponding with broadcast media programs that have one or more bookmarks, wherein the appearances of the

indicators vary to indicate differences in one or more properties associated with bookmarked broadcast media programs(see fig.5; program bookmarks can be displayed in the form of still photographs corresponding to the video scenes at the time a program is paused. An example of this type of display 500 is shown in FIG. 5. Other forms of bookmark icons and bookmark displays are possible given the teachings of the present,0056; Another variation of showing bookmarks isn't iconic at all, but rather completely textual, as shown in the display ).

Re claim 36, is met as previously discussed with respect to the rejection of claim 27.

As claim 37, the claimed "means for receiving, at a first multimedia system at a first location, a bookmark indicating a position within a multimedia program, the bookmark having been sent from a second multimedia system at a second location...; means for requesting that a communicatively coupled multimedia server stream to the first multimedia presentation system, multimedia program from the position of the bookmark; and means for presenting the multimedia program at the first multimedia presentation system from the position of the bookmark" is composed as the same structural elements as previously discussed with respect to the rejection of claim 27.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean Duclos Saintcyr whose phone number is 571-270-3224. The examiner can normally reach on M-F 7:30-5:00 PM EST.If attempts to reach the examiner by telephone are not successful, his supervisor, Brian Pendleton, can be reach on 571-272-7527. The fax number for the organization where the application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system,

Art Unit: 2425

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/Jean Duclos Saintcyr /

/Brian T Pendleton/

Supervisory Patent Examiner, Art Unit 2425